UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,577	01/25/2002	Toshihiro Morita	275734US6PCT	4188

			EXAMINER
22850	7590	11/17/2006	POND, ROBERT M

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ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _21 August 2006_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _12-20_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,4,5,8, and 11_ is/are rejected.

7)☒ Claim(s) _2,3,6,7,9 and 10_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant amended claims 1, 2, 5, 6, 8, 9, and 12. All pending claims not withdrawn (1-14) were examined in this final office action.

Response to Arguments

Applicant's arguments filed 21 August 2006 have been fully considered but they are not persuasive.

Background on Stefik

Stefik discloses original digital works, creating derivative works, and creating composite digital works, and defines a composite digital work comprising distinguishable parts, each of the distinguishable parts is itself a digital work which have usage rights attached. Stefik specifically discloses editing, copying, loaning, transferring, and extracting functions that facilitate creation of digital works, derivative digital works, and composite digital works. Stefik discloses assigning and tracking usage rights and specifically discloses the rights of a composite digital work being the minimal rights attached to a distinguishable part as determining the overall composite digital work usage rights. Stefik further discloses using an authoring tool or digital work assembly tool for creating a digital work having different usage rights for the varioius components (e.g. composite work).

Stefik discloses assigning and tracking usage rights associated with copying

or loaning of digital works for use and preventing use once usage right is

exhausted. Stefik discloses it being fundamental to the invention of Stefik that the

usage rights are treated as part of the digital work...as the digital work is

distributed, the scope of the granted usage rights will remain the same or may be

narrowed. Stefik further discloses that the basic idea is that one cannot grant

more rights than they have. By specific examples and disclosures, Stefik judges

whether one or more digital works are in use (i.e. copies, loaned, transferred).

Transferring content to an apparatus

Stefik discloses transferring digital content from a repository to a rendering

system. Stefik discloses a rendering system is generally defined as a system

comprising a repository and a rendering device which can render a digital work

into its desired form. Examples of a rendering system may be a computer

system, a digital audio system, or a printer. A rendering system has the same

security features as a repository. The coupling of a rendering repository with the

rendering device may occur in a manner suitable for the type of rendering device

(please see at least col. 8, lines 22-31).

Judging means of first and second content before combining content

Stefik discloses judging means of first content and second content before

content can be combined. This is the central issue separating the Applicant and

the Examiner on patentability. In light of the interview held with the Applicant's

attorney on 17 August 2006, the Examiner reviewed Fig. 1, Fig. 18 and

supporting disclosures in the Stefik patent. It is the Examiner's conclusion that any content that is requested is judged first before being transferred. Consequently, a user creating a composite work using an authoring tool as disclosed by Stefik comprising a first requested content and a second requested content has already been judged to not have been transferred. By example and to keep it simple, suppose a first content has been assigned a usage count of "one" and a second content has been assigned a usage count of "one." A user requests the first content which eventually is transferred to the user's apparatus. The copy usage count is now zero. The user then decides to combine the first content with the second content to create a composite work. When the user requests use of the first content again, the system will deny the request and terminate the transaction because it detects the first content copy count being zero (i.e. user has no more usage rights). In another words, the Applicant's claimed invention is a special case of Stefik when a copy usage count is initially set to "one."

Pertinent citings for the above discussions : C6,36-50; C9,8-20; C11,30-67; C18,16-20, C19,65-C20,2; C21,1-22, 23-24; C23,31-32; C41,7-13; C46, 15-33.

Please note: This office action is correcting a problem with the original Election/Restriction not determined by either the examiner nor the Applicant that identified claims 12-14 with elected Group I. Claims 12-14 should have been identified with Group II "dividing content." It is clear that office actions do not

address claims 12-14 and neither do the Applicant's arguments. Claims 12-14

are withdrawn as belonging to non-elected claims 15-20.

USC 112 Sixth Paragraph Notification

The Applicant has provided means and/or step-plus function language in the

instant claims, which could be construed as having a narrower meaning

emanating from specific embodiments found in the specification. Since it is the

applicant's responsibility to invoke USC 112 6th paragraph, the examiner will treat

the claims using the broadest reasonable interpretation unless the applicant

responds to the office action invoking USC 112 6th paragraph and identifying the

exact limitations that the applicant is reading into the claims from the

specification. Please be advised that should the applicant invoke USC 112 6th

paragraph in response to this office action the response may still be made final

using the rationale that the applicant has added new subject matter to the claims.

A lack of response to this notice will be construed as prosecution history estoppel

indicating that the applicant does not wish to invoke USC 112 6th paragraph.

Please note that present claim language does not meet the three-prong test

necessary to invoke USC 112 6th paragraph. Please see MPEP 2181.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

1. Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being

    indefinite for failing to particularly point out and distinctly claim the subject matter

    which applicant regards as the invention. The Applicant is claiming a program

    storage medium stored therein a computer-readable program. Claims lack

    specificity by omitting words to the effect of claiming "program code" or

    "instructions" or similar meaning for each claim element.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

2. **Claims 1, 4, 5, 8, and 11 are rejected under 35 USC 103(a) as being**

    unpatentable over Stefik (Paper #20051014, US 5629980).

    Stefik teaches rules for accessing electronic content also referred to a digital

    works. Stefik teaches users creating composite works comprising a collection of

    other digital works and determining usage rights of composite works. Stefik

    further teaches:

    - *a first judging step of judging whether a first content has been checked*

      out: (see at least Fig. 1 (105, 106, 107); Fig. 18, col. 31, line 5 through

      col. 32, line 43). System is aware that a digital work has been checked out

via the usage copy count. Please note: interpreting Applicant is invoking

35 USC 112, 6th paragraph.

- *and a second judging step of judging whether a second content has been*

  checked out: (see at least Fig. 1 (105, 106, 107); Fig. 18, col. 31, line 5

  through col. 32, line 43). System is aware that a digital work has been

  checked out via the usage copy count. Please note: interpreting Applicant

  is invoking 35 USC 112, 6th paragraph.

- *playback:* digital work playback, digital work player, playback protocol,

  play transactions, (see at least abstract; col. 5, line 67); unlimited usage

  rights can be obtained for a digital work (see at least

- *naming:* (see at least col. 39, lines 35-55).

- *system and means:* communication network means, content repositories

  management means, usage rights administration means, graphical user

  means; judging means (see at least Figs. 1, 2, 3, 4a, 4b, 18, and 19).

Stefik teaches all the above as noted under the 103(a) rejection and teaches

a) using authoring tools and editing applications to create digital works and/or to

modify content (see at least col. 11, lines 33-53, b) composite digital work

comprising of a collection of other digital works, c) the requester using the

process to change the contents of the digital work as desired by combining it with

other information (i.e. composite content) (see at least col. 41, lines 7-13), d)

embedded transactions to make a digital work become a part of another digital

work (see at least col. 40, lines 18-21), and e) judging step on each digital work

requested. Stefik, however, does not specifically disclose a content combining step of combining a first content and second content together when it is determined that neither the first nor second content has been checked out. One of ordinary skill in the art at time of invention would be able to ascertain that a requestor who desires to combine digital work A (DWA) with digital work B (DWB) would request each digital work in order to combine DWA with DWB. For example, suppose a DWA has been assigned a usage count of "one" and DWB has been assigned a usage count of "one." A user requests the DWA which eventually is transferred to the user's apparatus and used. The copy usage count is now zero. The user then decides to combine the DWA with DWB to create a composite work. When the user requests use of DWA again, the system will deny the request and terminate the transaction because it detects DWA's copy count being zero (i.e. user has no more usage rights). This example is consistent with the Stefiks disclosure and objectives of protecting the digital rights of each component digital work used in a composite digital work. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify Stefik to disclose by example combining a first content with a second content when it is determined than neither the first nor the second content has been checked out at ascertained by one of ordinary skill in the art, in order protect the digital rights of each component digital work used in a composite digital work.

Pertaining claims 1 and 4

Rejection of claims 1 and 4 is based on the same rationale as noted above.

Pertaining to claims 8 and 11

Rejection of claims 8 and 11 is based on the same rationale as noted above.

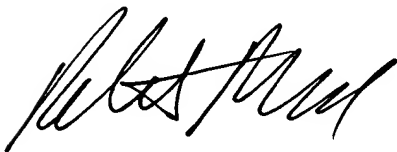## *Allowable Subject Matter*

3. Claims 2, 3, 6, 7, 9, and 10 are objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all

of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert M. Pond
Primary Examiner
November 12, 2006